

REMARKS**Rejection under 35 U.S.C. § 102(e)**

Claims 1-14, 15-35, 37, 39-41, 48-50, 56, 57, and 59-61 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,016,476 to Maes et al. (hereinafter “Maes”).

It is well settled that to anticipate a claim, the reference must teach every element of the claim. *See M.P.E.P. § 2131*. Moreover, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim.” *See M.P.E.P. § 2131*, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *See M.P.E.P. § 2131*, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully submit that the reference does not satisfy these requirements.

Claim 1

Claim 1 recites a method for activating a subscriber account for providing a network service that comprises:

- receiving initial information from a subscriber;
- storing said received information;
- providing a transaction processing device to said subscriber;
- receiving captured information from said subscriber through said transaction processing device;
- utilizing said captured information to receive verifying information about said subscriber; and
- comparing said verifying information with said initial information to authenticate said subscriber.

Maes is directed to a system that enables one of multiple account numbers to be written to a single “smart card” for use in consumer transactions. Specifically, a user establishes a subscription to the service and provides the user’s credit card account numbers to a central server. Col. 6, lines 59-66 of Maes. Also, the user provides identifying information (e.g., a PIN or voice data). Col. 7, lines 25-31. Subsequently, when the user

wishes to write an account number to the smart card, the user provides the identifying information to the central server using a personal digital assistant (PDA). Col. 8, lines 12-27. If the subsequently provided information matches the original information, the central server downloads a digital certificate to the PDA. The digital certificate enables an account number to be written to the smart card. Col. 11, lines 26-35. Thereafter, the smart card operates in the same manner as a typical credit card. Col. 11, lines 51-57.

As recited in claim 1, the transaction processing device is a device that is provided to the “subscriber.” The same transaction processing device is the device that captures information from the subscriber. Moreover, the captured information is not merely matched to previously stored information. Instead, the captured information obtained from the user through the device is used to receive separate verifying information. The separate verifying information is then compared to the initial information.

Maes does not use information captured from the user through the PDA to obtain other information. Instead, as soon as the captured information is obtained by the central server in Maes, it is compared to previously stored information that is associated with the user’s subscription account number. Accordingly, Maes does not disclose each and every limitation of claim 1 and, hence, does not anticipate claim 1.

Moreover, it is respectfully submitted that the PDA and the smart card of Maes are not transaction processing devices. Instead, the PDA merely writes an account number to the smart card. The smart card then merely acts in the same manner as a credit card. Accordingly, neither of these devices could be fairly characterized as meeting the transaction processing device element of claim 1.

Applicants respectfully submit that claim 1 is not anticipated. Claims 2-14, 15-35, 37, and 39-41 depend from claim 1 and, hence, inherit all limitations of claim 1. Claims 2-14, 15-35, 37, and 39-41 are also not anticipated.

Claim 48

Claim 48 is directed to a method for electronic authentication of a subscriber requesting a subscriber account for providing a payment processing service that comprises:

storing said received information in a database associated with said payment processor;...

receiving by said point of sale terminal identifying information from said subscriber, wherein said identifying information is captured by said transaction processing device, wherein at least a portion of said captured information is encrypted by said point of sale terminal;...

receiving said encrypted information from said point of sale terminal via a public network;

receiving verifying information from said third party server wherein said verifying information is related to said decrypted information provided to said third party server;

comparing said verifying information with said initial information by said payment processor to authenticate said subscriber; and

activating said subscriber account for performing said payment processing service upon authentication of said subscriber.

As previously discussed in regard to claim 1, Maes discloses a system including a central server for downloading digital certificates, a PDA, and a smart card. None of these items can be fairly interpreted to satisfy the “point of sale terminal” element of claim 48. Also, Maes does not disclose comparing information captured from the subscriber using the point of sale terminal to separate verifying information obtained from a third party server. Moreover, Maes does not activate a subscriber account for performing a payment processing service. Instead, Maes discloses allowing a user to perform ordinary retail transactions using multiple accounts via a single smart card.

Therefore, Applicants respectfully submit that Maes does not disclose each and every limitation of claim 48. Therefore, Applicants respectfully submit that claim 48 is not anticipated. Claims 49-50, 56, and 57 depend from claim 48 and, hence, inherit all limitations of claim 48. Claims 49-50, 56, and 57 are also not anticipated.

Claim 56

Claim 56 recites:

receiving initial information from a subscriber;
storing said initial information;

providing said transaction processing device to said subscriber;
receiving identification information from said subscriber through said transaction processing device;
communicating, by said transaction processing device through a network, said identification information to an authenticating server;
using, by said authenticating server, said identification information to obtain verifying information related to said subscriber; and
activating, by said authenticating server, said subscriber account when said verifying information is consistent with said initial information, wherein said activating enables said transaction processing device to initiate payments into said subscriber account from third parties via said network.

For the reasons discussed above with respect to claim 1, Applicants respectfully submit that Maes does not disclose each and every limitation of claim 56. Moreover, the devices described in Maes (the central server, the PDA, and the smart card) do not initiate payments into a subscriber account from third parties.

Therefore, Applicants respectfully submit that claim 56 is not anticipated. Claims 57 and 59-61 depend from claim 56 and, hence, inherit all limitations of claim 56. Claims 57 and 59-61 are also not anticipated.

Rejections under 35 U.S.C. § 103(a)

Claims 36 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maes in view of U.S. Patent No. 6,233,577 to Ramasubramani et al. (hereinafter “Ramasubramani”).

Claims 19 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Maes in view of U.S. Patent No. 5,721,781 to Deo et al. (hereinafter “Deo”).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the cited references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Applicants assert that the cited references do not satisfy these criteria.

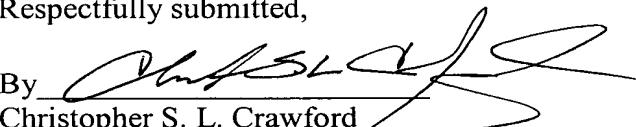
For the reasons discussed above in regard to the rejection under 35 U.S.C. § 102(e), Maes fails to disclose each and every limitation of independent claims 1, 48, and 56 from which claims 19, 36, 38, and 58 depend. Ramasubramani and Deo fail to remedy the lack of teaching and suggestion in Maes. Accordingly, the cited references (either alone or in combination) do not teach or suggest each and every limitation of claims 19, 36, 38, and 58. Applicants respectfully submit that a prima facie case of obviousness has not been established.

Conclusion

In view of the above amendment, Applicants believe the pending application is in condition for allowance. Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 56728/P002US/10005779 from which the undersigned is authorized to draw.

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Respectfully submitted,

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